UNILAB, INC. (formerly American Pharmaceuticals, Inc.), *Opposer,*	}	**IPC No. 14-2016-00454**
	}	Opposition to:
	}	Appln. Ser. No. 4-2016-502249
-versus-	}	Date Filed: 29 April 2016
GLENMARK PHARMACEUTICALS, LTD., *Respondent-Applicant.*	}	**TM: DOXOVENT**

x----------x

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2017 - 324 dated 30 August 2017 (copy enclosed) was promulgated in the above entitled case.

Pursuant to Section 2, Rule 9 of the IPOPHL Memorandum Circular No. 16-007 series of 2016, any party may appeal the decision to the Director of the Bureau of Legal Affairs within ten (10) days after receipt of the decision together with the payment of applicable fees.

Taguig City, 04 September 2017.

MARILYN F. RETUTAL
IPRS IV
Bureau of Legal Affairs

UNILAB, INC. (formerly **American** Pharmaceuticals, Inc.)
Opposer,

-versus-

GLENMARK PHARMACEUTICALS, LTD.,
Respondent-Applicant.
x----------x

IPC NO. 14-2016-00454

Opposition to:
Appln. Ser. No. 4-2016-502249
Filing Date: 29 April 2016
Trademark: **DOXOVENT**

Decision No. 2017 - 324

DECISION

UNILAB, INC.[1] ("Opposer") filed an Opposition to Trademark Application Serial No. 4-2016-502249. The application, filed by GLENMARK PHARMACEUTICALS, LTD.[2] ("Respondent-Applicant") covers the mark **DOXOVENT** for use on *"pharmaceuticals and medicinal preparations included in Class 5"* under Class 5 of the International Classification of goods[3].

The Opposer alleges the following:

"GROUNDS FOR OPPOSITION

x x x

"7. The mark 'DOXOVENT' applied for by Respondent-Applicant so resembles the trademark 'DUAVENT' owned by the Opposer and duly registered with the Honorable Bureau prior to the publication for opposition of the mark 'DOXOVENT'.

"8. The mark 'DOXOVENT' will likely cause confusion, mistake and deception on the part of the purchasing public, most especially considering that the opposed mark 'DOXOVENT' is applied for the same class of goods as that of the Opposer's trademark 'DUAVENT', *i.e.*, Class 05 of the International Classification of Goods as pharmaceutical preparations.

"9. The registration of the 'DOXOVENT' in the name of the Respondent will violate Sec. 123 (d) of the IP Code, which provides, in part, that a mark cannot be registered if it:

x x x

"10. Under the above-quoted provision, any mark which is similar to a registered mark shall be denied registration in respect of similar or related goods or if the mark applied for nearly resembles a registered mark that confusion or deception in the mind of the purchasers will likely result.

The Opposer's evidence consists of the following:

1. Printout of the IPOPHL E-Gazette dated 25 July 2016;
2. Certified copy of Certificate of Reg. No. 4-2004-001759 for the trademark "DUAVENT";

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[1] A corporation duly organized and existing under the laws of the Philippines with principal office located at No. 66 United Street, Mandaluyong City.
[2] A limited liability corporation organized and existing under the laws of India with address at B/2 Mahalaxmi Chambers, 22, Bhulabhai Desal Road, Mumbai, 400 026, India.
[3] The Nice Classification is a classification of goods and services for the purpose of registering trademark and service marks, based on the multilateral treaty administered by the World Intellectual Property Organization. The treaty is called the Nice Agreement Concerning the International Classification of Goods and Services for the Purpose of the Registration of Marks concluded in 1957.

3. certified copy of the Assignment of Registered Trademark executed on 11 July 1990 by UNILAB to L.R. Imperial;
4. Certified copy of a Petition for Renewal of Registration for the mark DUAVENT filed on 10 February 2015;
5. Declaration of Actual Use filed on 27 February 2006 and Affidavit of Use for 5th Anniversary filed on 20 November 2010;
6. Actual product packaging bearing the trademark "DUAVENT";
7. Certificates of Product Registration No. DR-XY30494 issued on 29 November 2013 and 25 May 2015, respectively; and
8. Certification issued by the IMSHEALTH.

This Bureau issued on 06 September 2016 a Notice to Answer and served a copy thereof to the Respondent-Applicant's counsel on 20 September 2016. The Respondent-Applicant, however, did not file an answer. On 06 June 2017, an Order was issued declaring Respondent-Applicant in default for failure to file the Answer. Accordingly, the case is deemed submitted for decision on the basis of the opposition, the affidavits of witnesses, if any, and the documentary evidence submitted by the Opposer.

Should the Respondent-Applicant be allowed to register the mark **DOXOVENT**?

Opposer anchors its opposition on Section 123.1 (d) of Republic Act No. 8293, also known as the "Intellectual Property Code of the Philippines" (IP Code), as amended, which provides:

> Section 123. *Registrability*. - 123.1. A mark cannot be registered if it:
>
> x x x
>
> (d) Is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date, in respect of:
>
> i. The same goods or services, or
> ii. Closely related goods or services, or
> iii. If it nearly resembles such a mark as to be likely to deceive or cause confusion;

Explicit from the afore-cited provision of the IP Code that whenever a mark subject of an application for registration resembles another mark which has been registered or has an earlier filing or priority date, said mark cannot be registered.

The records show that at the time the Respondent-Applicant filed its application for the mark DOXOVENT on 29 April 2016, the Opposer already has an existing registration for the trademark DUAVENT issued on 01 October 2005. As such, its certificate of registration is a *prima facie* evidence of the validity of the registration, its ownership of the mark, and of the exclusive right to use the same in connection with the goods or services specified in the certificate and those that are related thereto.[4]

But are the competing marks, as shown below, identical or similar or resemble each other such that confusion, mistake or deception is likely to occur?

DUAVENT	DOXOVENT
Opposer's Mark	Respondent-Applicant's Mark

[4] Sec. 138, Intellectual Property Code of the Philippines

A perusal of the composition of the competing trademarks involved in this case show that both marks contain identical suffix "VENT". "Vent" has a definitive meaning in the dictionary, that is, it is "an opening that allows air, smoke, or gas to escape or enter an enclosed space."[5] The word "vent" is commonly used in combination with other letters or words as a trademark especially in goods such as pharmaceutical preparations used to treat asthma or other respiratory diseases. In the IPOPHL Trademark Database, trademarks such as *VENTOLIN, VENTOSAL, AERO-VENT* and *VENTOBROX* are among the registered trademarks for use on pharmaceutical drugs for anti-asthma or anti-respiratory diseases. As such, the mere presence of the word "vent" in Respondent-Applicant's mark is insufficient to establish a finding of confusing similarity between the competing marks to sustain the opposition. That is why, what is crucial in the determination of whether Respondent-Applicant's mark is confusingly similar to Opposer's is the other letters / words combined to the word "vent.

In this case, the letters "D-U-A" precedes the word "vent" in Opposer's mark while it is the letters "D-O-X-O" in Respondent-Applicant's mark. While only the letter "D" is similar to the letters preceding the word "vent" in both marks, however, when pronounced Respondent-Applicant's mark sounds similar sound to that of Opposer's mark. Trademarks are designed not only for the consumption of the eyes, but also to appeal to the other senses, particularly, the faculty of hearing. Thus, when one talks about the Opposer's trademark or conveys information thereon, what reverberates is the sound made in pronouncing it. The same sound is practically replicated when one pronounces the Respondent-Applicant's mark.

In *Marvex Commercial Co. Inc. vs. Petra Hawpia & Co., and The Director of Patents*[6], the Supreme Court ruled:

> "Two letters of 'SALONPAS' are missing in 'LIONPAS': the first letter a and the letter s. Be that as it may, when the two words are pronounced, the sound effects are confusingly similar. And where goods are advertised over the radio, similarity in sound is of special significance (Co Tiong Sa vs. Director of Patents, 95 Phil. I, citing Nims, The Law of Unfair Competition and Trademarks, 4th ed., Vol. 2, pp. 678-679). 'The importance of this rule is emphasized by the increase of radio advertising in which we are deprived of the help of our eyes and must depend entirely on the ear' (Operators, Inc. vs. Director of Patents, supra).
>
> The following random list of confusingly similar sounds in the matter of trademarks, culled from Nims, Unfair Competition and Trade Marks, 1947, Vol. 1, will reinforce our view that 'SALONPAS' and 'LIONPAS' are confusingly similar in sound: 'Gold Dust' and 'Gold Drop'; 'Jantzen' and 'Jass-Sea'; 'Silver Flash' and 'Supper Flash'; 'Cascarete' and 'Celborite'; 'Celluloid' and 'Cellonite'; 'Chartreuse' and 'Charseurs'; 'Cutex' and 'Cuticlean'; 'Hebe' and 'Meje'; 'Kotex' and 'Femetex'; 'Zuso' and 'Hoo Hoo'. Leon Amdur, in his book 'Trade-Mark Law and Practice', pp. 419-421, cities, as coming within the purview of the idem sonans rule, 'Yusea' and 'U-C-A', 'Steinway Pianos' and 'Steinberg Pianos', and 'Seven-Up' and 'Lemon-Up'. In Co Tiong vs. Director of Patents, this Court unequivocally said that 'Celdura' and 'Cordura' are confusingly similar in sound; this Court held in Sapolin Co. vs. Balmaceda, 67 Phil. 795 that the name 'Lusolin' is an infringement of the trademark 'Sapolin', as the sound of the two names is almost the same.
>
> In the case at bar, 'SALONPAS' and 'LIONPAS', when spoken, sound very much alike. Similarity of sound is sufficient ground for this Court to rule that the two marks are confusingly similar when applied to merchandise of the same descriptive properties (see Celanese Corporation of America vs. E. I. Du Pont, 154 F. 2d. 146, 148)."

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[5] http://dictionary.cambridge.org/us/dictionary/english/vent <last accessed 30 August 2017>
6 G.R. No. L-19297. 22 December 1966

In addition, the likelihood of confusion between Opposer's and Respondent-Applicant's mark is made more apparent because the goods upon which Respondent-Applicant's mark is being applied for is generally couched as "pharmaceutical preparations under Class 05" which may also cover the goods of the Opposer bearing the mark DUAVENT. Thus, if allowed registration, there is likelihood that the usually unwary or incautious person would be confused or mistaken into believing that Respondent-Applicant's DOXOVENT is the same as Opposer's DUAVENT or that any impression or information regarding Respondent-Applicant's product bearing the mark DOXOVENT may be unfairly attributed to the Opposer.

It must be emphasized that the registration of trademarks involves public interest. Public interest, therefore, require that only marks that would not likely cause deception, mistake or confusion should be registered. The consumers must be protected from deception, mistake or confusion with respect to the goods or services they buy. Trademarks serve to guarantee that the product to which they are affixed comes up to a certain standard quality. Modern trade and commerce demands that depredations on legitimate trademarks should not be countenanced. The law against such depredations is not only for the protection of the owner but also, more importantly, for the protection of consumers from confusion, mistake, or deception as to the goods they are buying.[7]

Accordingly, this Bureau finds that the Respondent-Applicant's trademark application is proscribed by Sec. 123.1 (d) of the IP Code.

WHEREFORE, premises considered, the instant opposition is hereby ***SUSTAINED***. Let the filewrapper of Trademark Application Serial No. 4-2016-502249, together with a copy of this Decision, be returned to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 30 AUG 2017

Atty. MARLITA V. DAGSA
Adjudication Officer
Bureau of Legal Affairs

[7] *Le Chemise Lacoste, S.A. v. Oscar C. Fernandez et. al.*, G.R. Nos. 63796-97 and G.R. No. 65659, 21 May 1984.